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FROM: David Saliwanchik

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COMPANY: U.S. Patent Office
Art Unit 1617

DATE: August 10, 2005

FAX NO.: (571) 273-8300

NO. OF PAGES
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SUBJECT/MESSAGE:

Serial No. 08/816,079; filed March 13, 1997
Attorney Docket No. UF-1598

- 1) Petition Under 37 CFR 1.137(b) for Revival of an Application for Patent Abandoned
Unintentionally (4 pages)

The above-referenced Petition was submitted to the U.S. Patent Office on June 14, 2005. The Petitions Office records do not indicate that they have received the subject Petition. Therefore, attached is a copy of the Petition as submitted to the U.S. Patent Office.

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I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on June 14, 2005David Saliwanchik

David R. Saliwanchik, Patent Attorney

PETITION UNDER 37 CFR §1.137(b)
Examining Group 1617
Patent Application
Docket No. UF-1598
Serial No. 08/816,079

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner : Alysia Berman
Art Unit : 1617
Applicants : John F. Wironen and Jamie M. Grooms
Serial No. : 08/816,079
Filed : March 13, 1997
For : Bone Paste

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PETITION UNDER 37 CFR 1.137(b) FOR REVIVAL OF AN
APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY

Sir:

Petitioner, the University of Florida Research Foundation (hereinafter referred to as "Petitioner") hereby petitions the Commissioner to revive the patent application identified above in order to allow submission of a continuing application pursuant to 37 CFR 1.137(c). As set forth in more detail below, the Petitioner's failure to prosecute the application was unintentional. Furthermore, the entire delay from the date the application went abandoned until the filing of this Petition was wholly unintentional.

As required by 37 CFR 1.137(c), a continuation application accompanies this petition by separate paper. Furthermore, because this application was filed after June 8, 1995, it is not required that a terminal disclaimer accompany this Petition.

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The subject application was filed in the U.S. Patent and Trademark Office on March 13, 1997, relating to an invention entitled "Bone Paste." There are two inventors named on the application. The rights in this application for one of the inventors are assigned to the Petitioner. The other inventor assigned his interest in the invention to The University of Florida Tissue Bank, Inc. (hereinafter referred to as "TB"). Thus, there are two "owners" of this patent application — the Petitioner and TB.

Subsequent to filing the application, the Petitioner and TB entered into a contract on January 20, 1998, which granted to TB an exclusive license under the subject application. Pursuant to the terms of this contract, TB was to "seek issuance of" and "maintain" the subject application. TB was also required, in its fiduciary capacity, to use "all reasonable efforts to cooperate" with the Petitioner with respect to maintenance of the subject application. Furthermore, TB agreed to pay the Petitioner a minimum royalty each year.

TB retained the services of a patent attorney, Mr. Timothy VanDyke, to prosecute the subject application. On December 21, 2001, an Office Action was issued and transmitted to Mr. VanDyke. The file history obtained from the Patent Office shows that on June 21, 2002, in response to the Office Action, Mr. VanDyke filed an improper Continuation Prosecution Application. The file history further indicates that, on July 29, 2002, the Examiner contacted Mr. VanDyke to discuss the status of the application. Without discussing the matter at all with the Petitioner, Mr. VanDyke authorized the abandonment of the subject application. Notice of the abandonment was mailed from the Patent Office to Mr. VanDyke.

Despite the fact that the prosecution of this application had been entrusted to TB in its fiduciary capacity, the Petitioner was never consulted regarding the abandonment of this application, nor was the Petitioner informed of the abandonment of the application. The Petitioner never intended to abandon the subject application. Up until August 2004, the Petitioner regularly received a minimum royalty payment pursuant to the contract with TB. In view of the continued payments, and in view of TB's responsibility to prosecute the application to issuance, the Petitioner believed that TB had continued to prosecute the application.

In the fall of 2004, TB's licensee (Regeneration Technologies, Inc.) transmitted a letter to Petitioner stating that the subject application had been abandoned. This was the first time that the Petitioner was aware of the possible abandonment of the application. Thereafter, the Petitioner retained the services of an attorney, Mr. Peter Corless, to look into the matter and determine the status of the application. Mr. Corless determined that the application had, in fact, been abandoned and ordered the file history for this application from the U.S. Patent Office. In January 2005, the file history was delivered to the undersigned to conduct a review of the matter and to determine if the application could be revived. Upon review of the prosecution history, the relationship of the parties, and relevant events concerning the subject application, it became apparent that the Petitioner's failure to prosecute the subject application was unintentional. Accordingly, the Petitioner instructed the undersigned to seek revival of the subject application.

The Petitioner respectfully submits it never intended to abandon the subject application and that its delay in prosecuting the subject application was unintentional, if not unavoidable. The unintentional failure to prosecute this application occurred as a result of actions of a third party conducting the prosecution of the application solely in a fiduciary capacity. Thus, the failure by the Petitioner to prosecute was unintentional. Furthermore, the entire delay from the date the application went abandoned until the filing of this Petition was wholly unintentional.

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Docket No. UF-1598
Serial No. 08/816,079

In view of the foregoing, the Petitioner hereby prays that the subject patent application be revived as having been unintentionally abandoned.

Please charge the Petition fee of \$1,500.00 to Deposit Account No. 19-0065. The Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. 19-0065. Two copies of this Petition are enclosed for authorization of charges to the Deposit Account.

Respectfully submitted,



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DKS/hcy

Attachments: Continuing Application and Transmittal Forms